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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,161	03/19/2004	Mark W. Kimberlin	D-3054	7384
33197	7590	12/13/2005	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			SINGH, SUNIL	
4 VENTURE, SUITE 300			ART UNIT	
IRVINE, CA 92618			PAPER NUMBER	
			3673	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
10/805,161	KIMBERLIN, MARK W.	
Examiner	Art Unit	
Sunil Singh	3673	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7,9-15,17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over British document '682 in view of West et al..

British document '682 discloses a system for stabilizing a surface (see Fig. 1, page 1 line 10) prone to soil erosion, the system comprising: a porous element (10,12) disposed on a surface to be stabilized; and a flowable material (see page 1 lines 30-40, (14), page 2 lines 20-35, page 2 lines 75-80) incorporated within the porous element; the system being made by anchoring (10A) the porous element to the surface and thereafter injecting the flowable material (see page 1 line 84+) into the porous element and thereafter allowing the flowable material to set within openings defined within the porous element (see page 1 lines 25-40, page 2 lines 20-35). The porous element is a cellular matting (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30). The porous element comprises a netting material (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30) comprises a netting material. The porous element comprising a reinforced fiber matting (10,12). The flowable material forms a solidified material within

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said openings (see page 1 lines 30-40, (14), page 2 lines 20-35) thereby forming a microclimate favorable to growth of vegetation from said surface through said porous element (page 2 lines 75-80). British document discloses the invention substantially as claimed. However, British document lacks a flowable material comprising a mixture of fibers and a polymeric bonding material being applied using conventional seeding apparatus. White et al. teaches flowable material comprising a mixture of fibers, seeds and a polymeric bonding material (see abstract) being applied using conventional seeding apparatus (see col. 2 thru col. 5 ). It would have been considered obvious to one of ordinary skill in the art to modify British document '682 by substituting the flowable material with its corresponding applicator as taught by West et al. for the flowable material and its corresponding applicator disclosed by British document '682 since this allows for planting of seeds which ultimately results in plants becoming established thus further preventing erosion

With regards to claim 22, claim 22 is considered to be a product-by-process claim, and the examiner notes that it has been held that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in a product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) see MPEP 2113.

### ***Response to Arguments***

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For example, British document discloses applying a flowable material to a porous element (see page 1 lines 1-40, page 2 lines 10-40), allowing the flowable mixture to solidify (see page 1 lines 1-40, page 2 lines 10-40), forming a microclimate favorable to growth of vegetation from said surface through said porous element (see page 2 lines 70-80). On the other hand, White et al. teaches flowable material comprising a mixture of fibers, seeds and a polymeric bonding material (see abstract) being applied using conventional seeding apparatus (see col. 2 thru col. 5 ). Thus when British document is modified in view of White et al. the claimed subject matter is then met.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suzanne Barrett can be reached on (571) 272-7053. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh  
Primary Examiner  
Art Unit 3673



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12/5/05